

U.S. Patent Application Serial No. 10/606,928

Amendment filed May 31, 2007

Reply to OA dated January 31, 2007

REMARKS

Claims 1 and 3-4 are pending in this application. No amendment to the claims is proposed herein. An amendment to the specification is proposed.

The Applicants respectfully submits that no new matter is added by this amendment. Support for this amendment is detailed below. It is believed that this Response is fully responsive to the Office Action dated **January 31, 2007**.

Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bando et al. in view of Maeda et al. (6,338,917). (Office action paragraph no. 1)

The rejection is respectfully traversed, and reconsideration of the rejection is requested.

In the previous Amendment, Applicant had argued that Bando and Maeda do not disclose that the cobalt compounds on the nickel electrodes contain alkali metal ions. The Examiner, however, on page 3, second paragraph, states that Bando et al. discloses: "that it is well known in the art for the cobalt compound to contain alkali metal ions (col. 1 line 30-31) for the purpose to form a higher cobalt oxide of high conductivity on the surface of the particulate nickel hydroxide (col. 1 lines 30-33)." The Examiner also reiterates this argument in the Response to Arguments on page 5 of the Office action.

The portion of Bando referred to by the Examiner (column 1, lines 30-31) is in the Background section of the reference, where it states:

"With a view to realize the aforementioned sufficient electric contact, various methods haven been adopted, e.g. a method wherein cobalt metal or a cobalt compound is added as a conductivity assistant to a paste and then converting the cobalt metal or compound into a high-order cobalt oxide of high conductivity by subjecting it to an initial charging, or a method wherein cobalt hydroxide is first formed on the surface of particulate nickel hydroxide, which is then subjected to a heat treatment in the presence of alkali so as to form a high order cobalt oxide of high conductivity on the surface of the particulate nickel hydroxide." (col. 1, lines 23-32)

That is, the Examiner refers to a prior art method involving heat-treatment of cobalt hydroxide in the presence of alkali so as to form a high order cobalt oxide, with the assumption that this inherently produces a cobalt compound containing alkali metal ions.

It is possible, although not completely certain, that this prior art cobalt oxide would have alkali metal ions (as a result of the alkali treatment). However, the cited prior art of column 1, lines 30-31, **does not** have niobium, titanium, tungsten or molybdenum introduced into the nickel hydroxide.

The rejection of the present claims, as mainly stated, is based not on this portion of the disclosure of Bando, but on Bando's cobalt compound in column 2, lines 50-55. This cobalt compound is further described in column 3, lines 7-10, as containing "**β type cobalt hydroxide**," with no mention of alkali metal ions. (See also column 3, lines 30-34, and column 3, lines 43-46). This is clearly different from the prior art of column 1, lines 30-31, and there is no suggestion in Bando for the cobalt compound in column 2, lines 50-55, to have alkali metal ions in Bando's inventive electrode. There is clearly no suggestion to make Bando's cobalt compound of column 2,

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lines 50-55, by the prior art method of column 1, lines 23-32; these are completely different compositions, and Bando's inventive composition is clearly different from the cited prior art.

Applicant therefore submits that the Examiner has not made a *prima facie* case of obviousness, and Applicant maintains the argument that neither Bando nor Maeda discloses the use of a cobalt compound having alkali metal ions **in combination with** a nickel electrode having an introduced niobium, titanium, tungsten or molybdenum compound.

Claims 1 and 3-4 are therefore not obvious over Bando and Maeda, taken separately or in combination.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. (Office action, page 4)

The Examiner states that the term "alkali metal ions" is a new limitation, which is different from "alkaline cations."

Reconsideration of the rejection is respectfully requested in view of the following remarks and the attached verified translations of the priority documents, JP 2002-189984 and JP 2003-090535.

Applicant again submits that the term "alkali metal ions" is the correct term in standard chemical nomenclature, and that the previous amendment amending "alkaline cations" to --alkali metal ions-- did not represent new matter.

In traversing the rejection, Applicant amends the specification in accordance with **37 CFR**

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1.57 (Incorporation by Reference), arguing that the wording of "alkaline cations" in the original specification represented, in effect, an **inadvertent omission** of a portion of the specification from the foreign applications from which the present application claims priority. Specifically, the Japanese term meaning "alkali metal ions" was inadvertently translated as "alkaline cations."

In accordance with 37 CFR 1.57(a)(1)(i), Applicant has already provided copies of the prior-filed foreign applications; in accordance with 37 CFR 1.57(a)(1)(ii), Applicant here provides verified translations of the priority documents, JP 2002-189984 and JP 2003-090535.

In accordance with 37 CFR 1.57(a)(1)(iii), it can be seen that the terms previously translated as "alkaline cations" are translated correctly as "alkali metal ions" in these verified translations. For example, in paragraph [0012] of JP2003-189984, it states that: "In this case, if the layer of the cobalt compound contains alkali metal ion, the conductivity of the layer of the cobalt compound is further enhanced, so that the layer of the cobalt compound is preferably a layer of a cobalt compound containing alkali metal ion." This can be seen to correspond to page 8, line 2, of the present specification. Paragraph [0012] of JP2003-090535 can be seen to correspond to the last line of the paragraph beginning at page 12, line 3, of the specification. Similarly, the occurrence of "alkali metal ion" in paragraph [0016] of JP 2002-189984 can be seen to correspond to the paragraph beginning at page 15, line 4, of the specification.

Accordingly, the occurrences of "alkaline cations" in the present specification have been amended to --alkali metal ions-- in the present specification amendment, and this amendment represents an **Incorporation by Reference** from the priority documents.

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Moreover, Applicant again submits that "alkali metal ions" is the correct chemical term here. Applicant respectfully notes that the Examiner states in the response that "Alkaline elements are Be, Mg, Ca" and "alkali elements are Na, Li, K, Rb, Cs and Fr." However, Applicant respectfully submits that this is not correct. Be, Mg, Ca, etc., are known as the "alkaline earth metals," and not as the "alkaline elements." Na, Li, K, Rb, etc., are known as the "alkali metals," and not as the "alkali elements."

Reconsideration of the rejection is therefore respectfully requested.

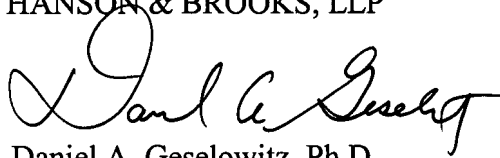
If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP



Daniel A. Geselowitz, Ph.D.
Agent for Applicant
Reg. No. 42,573

DAG/ejb
Atty. Docket No. 030777
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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Enclosures: Verified English Translations of JP2002-189984 and JP2003-090535

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